

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Jeong-Kyu MOON

Examiner: Pierre Louis DESIR

Serial No.: 10/646,153

Group Art Unit: 2617

Filed: August 21, 2003

Docket: 678-1123 (P10535)

For: **METHOD FOR PERFORMING A ONE-TOUCH CALL OPERATION
USING A WIRELESS MOBILE TERMINAL**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

TRANSMITTAL OF APPELLANTS' BRIEF ON APPEAL

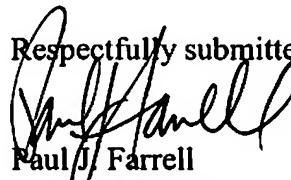
Sir:

Enclosed please find APPELLANTS' BRIEF.

Also enclosed is the appeal fee in the amount of \$510.00.

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Respectfully submitted,



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

APPLICANT(S): Jeong-Kyu MOON **GROUP ART UNIT:** 2617

APPLICATION NO.: 10/646,153 **EXAMINER:** Pierre Louis DESIR

FILING DATE: August 21, 2003 **DATED:** September 30, 2008

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APPELLANT'S BRIEF ON APPEAL

REAL PARTY IN INTEREST

The real party in interest is Samsung Electronics Co., Ltd., the assignee of the subject application, having an office at 416, Maetan-dong, Yeongtong-gu, Suwon-si, Gyeonggi-do, Republic of Korea.

RELATED APPEALS AND INTERFERENCES

To the best of Appellant's knowledge and belief, there are no currently pending related appeals, interferences or judicial proceedings.

STATUS OF CLAIMS

The original application filed on August 21, 2003 contained Claims 1-10. In a Response filed September 1, 2005, Claim 1 was amended. In a Response filed February 21, 2006, Claims 1-3 were cancelled. In a Response filed April 21, 2006, Claims 4 and 8 were amended. In a Response filed February 22, 2007, Claims 4 and 8 were amended.

Thus, Claims 4-10 are pending in the Appeal. Claims 4 and 8 are in independent form.

For the purposes of this appeal, Claims 4-10 stand or fall together.

STATUS OF AMENDMENTS

To date, all of the amendments to the claims have been entered. Thus, the Appendix to this Appeal Brief includes Claims 4-10, of which the status of Claims 4 and 8 are indicated as "Previously Presented," the status of Claims 5-7, 9 and 10 are indicated as "Original," and the status of Claims 1-3 are indicated as "Cancelled."

SUMMARY OF CLAIMED SUBJECT MATTER

The invention as recited in Claim 4 relates to a method for performing a one-touch call operation using a mobile terminal. The method includes attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal. (Specification at page 4, lines 22-24, and FIG. 2, S50).¹ The method further includes, if the call connection between the mobile terminal and the counterpart mobile terminal fails, pressing a one-touch call button of the mobile terminal that transmits, using information entered during the attempt to establish the call connection, a predetermined message corresponding to the one-touch call button to the counterpart mobile terminal. (Specification at page 4, line 24, through page 5, line 13, and FIG. 2, S52-58).

¹ Although a citation for each feature of the claims is provided herein, Appellant notes that support may be found elsewhere in the written description.

The invention as recited in Claim 8 relates to a method for performing a one-touch call operation using a mobile terminal. The method includes attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal. (Specification at page 4, lines 22-24, and FIG. 2, S50). The method further includes, if the call connection between the mobile terminal and the counterpart mobile terminal fails, pressing a one-touch call button of the mobile terminal. (Specification at page 7, lines 10-11, and FIG. 4, S80). The method yet further includes transmitting, using information entered during the attempt to establish the call connection, a phone number of the mobile terminal and a predetermined message, corresponding to the one-touch call button to the counterpart mobile terminal. (Specification at page 7, lines 13-15, and FIG. 4, S84).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether Claims 4, 5, 7, 8 and 10 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,639,973 to *Wheeler et al.* (hereinafter, *Wheeler*) in view of U.S. Patent No. 5,703,932 to *Oda*.

Whether Claims 6 and 9 are unpatentable under 35 U.S.C. §103(a) over *Wheeler*, *Oda* and U.S. Publication No. 2002/0073142 to *Moran*.

ARGUMENT

The Examiner rejected Claims 4-10 under 35 U.S.C. §103(a) as being unpatentable over one or more of *Wheeler*, *Oda* and *Moran*.

I. Provisional Nonstutory Obviousness-Type Double Patenting Rejection of Claims 4 and 8

The obviousness-type double patenting rejection of Claims 4 and 8² is not presented for review in this appeal due to the fact that it is a provisional rejection and the conflicting claims have not yet been patented. Thus, the issue is not yet ripe for appeal, and Appellant respectfully reserves the right to address this rejection at a later time if necessary.

II. Claims 4, 5, 7, 8 and 10 are patentable over the combination of *Wheeler* and *Oda*

A. Claim 4

The Examiner contends that each element of Claim 4 is taught, suggested or rendered obvious by the combination of *Wheeler* and *Oda*.³ More specifically, the Examiner contends that *Wheeler* teaches each element of Claim 1 with the exception of the pressing of a one-touch call button of the mobile terminal. The Examiner cites *Oda* in an attempt to remedy this deficiency.⁴

Claim 4 recites a method for performing a one-touch call operation using a mobile terminal. The method includes attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal. The method further includes, if the call connection between the mobile terminal and the counterpart mobile terminal fails, pressing a one-touch call button of the mobile terminal that transmits, using information entered during the attempt to establish the call connection, a predetermined message corresponding to the one-touch call button to the counterpart mobile terminal.

Wheeler discloses that when a connection is unable to be completed, control is returned from the terminating party call control through a network to call control logic of the originating party call control or directly to the originating subscriber.⁵ *Oda* discloses a cellular telephone convenient for one touch signal transmission.⁶

The Examiner contends that *Wheeler* teaches or suggests that information entered during the attempt to establish a call connection is used to transmit a predetermined message to a counterpart mobile terminal.⁷ However, *Wheeler* describes the pre-configuration of options for particular individuals as groups in the event they are not reachable.⁸ Thus, *Wheeler* utilizes prestored information in performing an action after a failed call attempt, and fails to disclose the

² See Office Action dated April 30, 2008, page 2.

³ See Office Action dated April 30, 2008, page 8.

⁴ See Office Action dated April 30, 2008, page 8.

⁵ See *Wheeler*, Abstract.

⁶ See *Oda*, Abstract.

⁷ See Office Action dated April 30, 2008, page 8.

⁸ See *Wheeler*, column 4, lines 36-46.

use of information entered during a call attempt, as recited in Claim 1. *Oda* fails to provide any disclosure that remedies this deficiency of *Wheeler*.

Oda describes that signals may be transmitted by one-touch.⁹ However, *Oda* also describes that the signals are transmitted to a person or location stored beforehand in correspondence to each key.¹⁰ *Oda* fails to disclose that a predetermined message corresponds to the one-touch call button, as recited in Claim 1.

Accordingly, *Oda* fails to remedy the deficiency of *Wheeler* described above and thus, the combination of *Wheeler* and *Oda* fails teach or suggest each and every element of Claim 4. Further, the elements of Claim 4 are not obvious in view of the combination of *Wheeler* and *Oda*. Therefore, it is respectfully submitted that Claim 4 is believed to be allowable over the combination of *Wheeler* and *Oda*.

B. Independent Claim 8

The Examiner also rejected independent Claim 8 under 35 U.S.C. 103(a) contending that Claim 8 contained recitations similar to those set forth in Claim 4.¹¹

Claim 8 recites a method for performing a one-touch call operation using a mobile terminal. The method includes attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal. The method further includes, if the call connection between the mobile terminal and the counterpart mobile terminal fails, pressing a one-touch call button of the mobile terminal. The method yet further includes transmitting, using information entered during the attempt to establish the call connection, a phone number of the mobile terminal and a predetermined message, corresponding to the one-touch call button to the counterpart mobile terminal.

Appellant asserts that Claim 8 is patentable for at least the reasons presented above with regard to Claim 4. More specifically, Claim 8 recites the step of pressing a one-touch call button of the mobile terminal, and transmitting a phone number and a message using information entered during the attempt to establish a call connection. As described above with regard to Claim 4,

⁹ See *Oda*, column 2, lines 5-14.

¹⁰ See *Oda*, column 3, lines 58-65.

Wheeler fails to teach or suggest the use of information entered during a call attempt, which is not remedied by the disclosure of *Oda*. Further, *Oda* fails to teach or suggest that a predetermined message corresponds to the one-touch call button, which is not remedied by the disclosure of *Wheeler*.

Thus, the combination of *Wheeler* and *Oda* fails teach, suggest or render obvious each and every element of Claim 8. Further, the elements of Claim 8 are not obvious in view of the combination of *Wheeler* and *Oda*. Therefore, it is respectfully submitted that Claim 8 is believed to be allowable over the combination of *Wheeler* and *Oda*.

C. Dependent Claims 5, 7 and 10

Regarding the rejection of Claims 5, 7 and 10, the claims are patentable at least by virtue of their dependency from independent Claims 4 and 8. The patentability of Claims 4 and 8 is described above. Claims 5, 7 and 10 also recite patentable subject matter in their own right. Accordingly, it is respectfully submitted that because the above arguments place the independent claims in condition for allowance, that these dependent claims are also believed to be in condition for allowance. Therefore, the combination of *Wheeler* and *Oda* fails to teach, suggest or render obvious every element of Claims 5, 7 and 10, and it is respectfully submitted that Claims 5, 7 and 10 are patentable over the combination of *Wheeler* and *Oda*.

Accordingly, Appellant asserts that Claims 4, 5, 7, 8 and 10 are allowable over the combination of *Wheeler* and *Oda*, and respectfully requests withdrawal of the rejection under 35 U.S.C. §103(a).

¹¹ See Office Action dated April 30, 2008, page 9.

III. Claims 6 and 9 are patentable over the combination of *Wheeler, Oda and Moran*

A. Dependent Claims 6 and 9

The Examiner contends that the elements of Claims 6 and 9 are taught, suggested or rendered obvious by the combination of *Wheeler, Oda and Moran*.¹² More specifically, the Examiner contends that the combination of *Wheeler* and *Oda* teaches each element of Claims 6 and 9 with the exception of a predetermined message being a previously recorded voice message. The Examiner cites *Moran* in an attempt to remedy this deficiency.¹³

Moran discloses that a user is able to pre-record voice messages stored at a messaging server,¹⁴ but fails to provide any disclosure that remedies the deficiencies of *Wheeler* and *Oda* described above. While not conceding the patentability of the dependent claims, *per se*, Claims 6 and 9 are also patentable for at least the above reasons. Accordingly, Appellant asserts that Claims 6 and 9 are allowable over *Wheeler, Oda, Moran*, or any combination thereof, and the rejection under 35 U.S.C. §103(a) should be withdrawn.

CONCLUSION

It is well settled that in order for a rejection under 35 U.S.C. §103(a) to be appropriate, the claimed invention must be shown to be obvious in view of the prior art as a whole. A claim may be found to be obvious if it is first shown that all of the recitations of a claim are taught in the prior art or are suggested by the prior art. *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974), cited in M.P.E.P. §2143.03.

The Examiner has failed to show that all of the recitations of Claims 4-10 are taught or suggested by the art of record, or the combination thereof. Accordingly, the Examiner has failed to make out a *prima facie* case for an obviousness rejection.

¹² See Office Action dated April 30, 2008, page 11.

¹³ See Office Action dated April 30, 2008, page 11.

¹⁴ See *Moran*, Abstract.

As the Examiner has failed to make out a prima facie case for obviousness rejections, the rejections of Claims 4-10 must be reversed.

Dated: September 30, 2008

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CLAIMS APPENDIX

1-3. (Cancelled)

4. (Previously Presented) A method for performing a one-touch call operation using a mobile terminal, comprising the steps of:

attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal; and

if the call connection between the mobile terminal and the counterpart mobile terminal fails, pressing a one-touch call button of the mobile terminal that transmits, using information entered during the attempt to establish the call connection, a predetermined message corresponding to the one-touch call button to the counterpart mobile terminal.

5. (Original) The method as set forth in claim 4, wherein the step pressing the one-touch call button of the mobile terminal, includes the steps of:

reading out a phone number of the mobile terminal and the predetermined message from a memory of the mobile terminal; and

simultaneously transmitting the phone number of the mobile terminal and the predetermined message to the counterpart mobile terminal.

6. (Original) The method of Claim 4, wherein the predetermined message is a previously recorded voice message.

7. (Original) The method of Claim 4, wherein the predetermined message is a previously entered text message.

8. (Previously Presented) A method for performing a one-touch call operation using a mobile terminal, comprising the steps of:

attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal;

if the call connection between the mobile terminal and the counterpart mobile terminal fails, pressing a one-touch call button of the mobile terminal; and

transmitting, using information entered during the attempt to establish the call connection, a phone number of the mobile terminal and a predetermined message corresponding to the one-touch call button to the counterpart mobile terminal.

9. (Original) The method of Claim 8, wherein the predetermined message is a previously recorded voice message.

10. (Original) The method of Claim 8, wherein the predetermined message is a previously entered text message.

EVIDENCE APPENDIX

There is no evidence submitted pursuant to 37 C.F.R. 1.130, 1.131, 1.132 or entered by the Examiner and relied upon by Appellant.

RELATED PROCEEDINGS APPENDIX

There are no known decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of 37 C.F.R. 41.37.